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Response under 37 CFR § 1.105

GROUP 3600

Appln. Ser. No.:	Filed:	Inventor(s):	Atty Dkt:
09/543,951	6 April 2000	W. Dalton	1633-015A
Title: Improved Brush Seal Designs for Turbines and Similar Rotary Apparatus			
Examiner: M. Rogers		Art Unit: 3677	

Asst. Comm'r for Patents  
Washington, D.C. 20231-0001

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**FIRST RESPONSE TO FINAL OFFICE ACTION**

Dear Sir:

In complete and timely response to the Office action mailed 27 January 2003, in which the rejection of claims 1-9 have been designated as final, Applicants respectfully request reconsideration of the rejection in light of the following remarks.

The Examiner's Response cites *In re Keller* for the proposition that the rejection does not pick and choose among the elements of the references but that the combined teachings of the references support the rejection. In *Keller* the issue was whether the absence of digital timing in the Walsh reference rendered obvious the claimed cardiac pacer with a digital counter, and Keller's expert's declaration only addressed whether it would have been obvious for Walsh to have used a digital timer, not the combination of Keller's prior publication with Walsh (or another reference with Walsh). Thus, the Court found that the declaration attacked the references individually. 208 U.S.P.Q. at 882.

Such is not the case here. The Examiner admits that Mr. Sulda's declaration addresses the *combination* of the references, using the Bagepalli brush in Brandon, as was the basis for the rejection, and so the *prima facie* case of obviousness must be addressed taking into account the applicants' entire showing. *Ex parte Keyes*, 214 USPQ 579, 580 (BPAI 1982) (citing *Keller*).

Mr. Sulda explains why the references cannot be combined properly. But the final rejection does not reweigh all the evidence as required. *In re Hedges*, 228 USPQ 685 (Fed. Cir. 1986) (citing *In re Plasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984)). The facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 14 USPQ2d 1741 (Fed. Cir. 1990); *In re Rinehart*, 189 USPQ 143 (CCPA 1976).

The Examiner has not addressed why ignoring the fact that Bagepalli is directed to a stationary seal, as opposed to a retractable seal, is not picking and choosing within the reference disclosure only so much as is needed to make out the rejection. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416, 419 (Fed. Cir. 1986) (citing *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) and *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975)). Even though Bagepalli is directed to a seal similar to that in Brandon, it is clearly a seal that is not designed to move. Ignoring such a specific teaching of the reference is improper. *Id.* at 420 ("The district court also failed to consider the Caddell reference in its entirety and thereby ignored those portions of the reference that argued against obviousness.") Clearly, a reference directed to a seal that does not retract has portions of its disclosure that teach away from a seal that retracts. Those portions of the reference that teach away cannot be ignored when the references are combined. Stating what is allegedly well-known (a segmented brush with intermeshing angled ends in a labyrinth seal) does not address what happens to the context in which that teaching is found (*Kotzab* at 1317), namely a brush that is static and does not retract. Regardless of worker safety, the static structure in which Bagepalli's brush is housed, and the specifics of that structure, cannot be ignored, otherwise the rejection is based on the mere identification in the reference of components corresponding to the claimed elements. *Id.* Taking an angled brush from a reference and then deciding to mount differently than taught by the reference is picking and choosing the reference disclosure while ignoring contrary teachings.

The Examiner is requested to substantiate the allegation that Mr. Sulda's declaration is untrue when that declaration states that the physical overlap<sup>1</sup> of the mounting block would prevent the seal segments from properly retracting. The Examiner has provided no declaration under 37 CFR § 1.104(d)(2), has cited no reference under § 1.104(d)(1) to show that the static structure of Bagepalli can be dynamic (retractable) in spite of this physical overlap, and has not even addressed the structure shown in the reference drawings and discussed in the declaration. The Examiner has no basis, other than citing to a *lack* of description in the references to everyday occurrences in this field, that statements in the declaration are untrue. Absent a valid basis for dismissing statements in the declaration, the statements in the declaration must be accepted as true.

The Examiner's statement that friction is related solely to the materials used is unsupported by any evidence or declaration by the Examiner under §1.104. Mr. Sulda's declaration attests to his experience in the art to which this application is directly related. The Examiner's supposition of "excess friction" being a factor is not supported by any reasoning or other experience (§ 1.104), nor is excess friction discussed in Mr. Sulda's declaration. Rather, ¶ 17 of Mr. Sulda's declaration states that three factors would be required for the Bagepalli segments to function in a retractable manner, one of which is equal friction among the segments. There is no mention of the amount of friction, but that the friction among all of the segments must be balanced. The Examiner's comments on friction do not address any of the factors mentioned in ¶ 17 of the declaration. More importantly, the Examiner appears to have missed the entire point of that discussion: because of the physical overlap of Bagepalli's segments, the segments would have to act as ideal segments for Bagepalli's structure to retract, but that real world problems, like friction, would prevent that structure from being retractable.

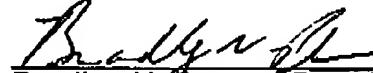
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<sup>1</sup> ¶ 16 of Mr. Sulda's declaration: "With reference to Figures 2 and 3 of the [Bagepalli] '175 patent, the hybrid seal disclosed in that patent has an overlap in the direction of the axial axis, between the mounting block 48 and the seal segments 26 and 28 of the mating circumferential portions. This overlapping arrangement would restrict or hinder the intended radial movement of the retractable brush seal packing segments of the '951 patent application."

The citation in the final rejection to *In re McLaughlin* should not overlook that that Court found persuasive affidavit evidence concerning the problems in the art and that applicant's solution to the problem, reversing the rejection of claim 15 in that case. Further, taking into account only knowledge at the time of invention cannot exclude the contemporaneous teachings of that knowledge; namely, the context and structures related to those teachings and consequently teachings that also lead away from the claimed invention. "The art of record clearly fails to recognize the specific problem addressed by appellant, and just as clearly fails to suggest the claimed solution." *Keller* at 581. See also *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Accordingly, absent a reconsideration of the rejection based on first principles in light of the statements in Mr. Sulda's declaration, the final rejection should be withdrawn and the present claims should be allowed.

Respectfully submitted,

  
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3 February 2003

**CERTIFICATE OF MAILING OR  
TRANSMISSION — 37 CFR 1.8**

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: 3 February 2003  
NAME: Brad Ruben  
SIGNATURE: Brad Ruben